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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Dirk Kranendonk

Serial No.: 09/966,309

Group Art Unit: 1771

Filed: September 28, 2001

Examiner: N. L. Torres-Velazquez

For: POLYMER COATED WALL COVERING MATERIAL

Attorney Docket No.: 25098A

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APPEAL BRIEF

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Sir:

Appeal is taken from the rejection of pending claims 1-13 and 22-40 made in the Office Action of August 30, 2006. No claim has been allowed. A timely Notice of Appeal was filed on December 13, 2006. If necessary, the Commissioner is hereby authorized to charge payment or credit any overpayment to Deposit Account No. 50-0568 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

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### **I. REAL PARTY IN INTEREST**

The inventor assigned 100% of his interest in the present invention as embodied in U.S. Patent Application Serial No. 09/966,309 to Owens-Corning Fiberglas Technology, Inc., an Illinois corporation having a place of business at 7734 West 59<sup>th</sup> Street, Summit, Illinois 60501. Owens-Corning Fiberglas Technology, Inc., assigned its interest to the following real party in interest: Owens-Corning Veil U.K. Limited ("Owens Corning" or "Appellant"), a United Kingdom Corporation having a place of business at Liversedge, West Yorkshire, United Kingdom WF15 8AA.

## II. RELATED APPEALS AND INTERFERENCES

Appellant knows of no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

### III. STATUS OF THE CLAIMS

Claims 1-13 and 22-40 remain pending in the application and are the subject of this appeal.

Claims 1, 8, and 30 are rejected as allegedly violating 35 U.S.C. Section 112.

Claims 1, 3-5, 9, 11-12, 22-23, 25-27, 31, 33-34, 36 and 40 stand rejected under 35 U.S.C. Section 102(b) as being anticipated by U.S. Patent No. 5,876,551 to Jackson ("Jackson") as further evidenced by WO 95/07946.

Claims 2, 8, 24, 30, 34, and 37 stand rejected under 35 U.S.C. Section 103(a) as being obvious in view of Jackson.

Claims 10, 13, 32, 35 and 38-39 stand rejected under 35 U.S.C. Section 103(a) as being obvious in view of Jackson and further in view of U.S. Patent No. 6,281,277 to Ishii et al. ("Ishii").

Claims 6-7 and 28-29 stand rejected under 35 U.S.C. Section 103(a) as being obvious in view of Jackson and Ishii, and further in view of U.S. Patent No. 5,888,913 to Penz et al. ("Penz").

Claims 13, 35, and 38 stand rejected under 35 U.S.C. Section 103(a) as being obvious in view of Jackson and Ishii, and further in view of U.S. Patent No. 4,898,892 to Melber et al. ("Melber").

#### **IV. STATUS OF AMENDMENTS**

The form of the claims for purposes of this appeal is as presented in the response of August 14, 2006. For the convenience of the Board, a copy of the pending claims appears in the attached Claims Appendix.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

The inventions of the independent claims are concisely summarized in the following manner. Claim 1 of the present application reads on a fiber reinforced polymeric wall covering material 50. The material 50 of this claim comprises a non-woven fiber tissue 52 or mat having an inner side and an outer side (p. 7, ll. 5-6 and Figures 1-2). A thermoplastic polymer coating 54 covers the outer side of the non-woven fiber tissue 52 or mat in a continuous fashion to reduce significantly the porosity of the wall covering (p. 3, ll. 8-10). The thermoplastic polymer 54 coating provides a regular, roller paintable visible outer surface on the non-woven fiber tissue 52 or mat (p. 7, ¶ 3 generally and p. 8, last paragraph). This surface is free of random discontinuities that result in increased porosity and which are susceptible to creating visible irregularities when the surface is roller painted (Figure 2).

Claim 23 also covers a fiber reinforced polymeric wall covering material 50. The material of this claim also comprises a non-woven fiber tissue or mat 52 having an inner side and an outer side and a thermoplastic polymer coating 54 applied to the outer side thereof (p. 7, ll. 5-6 and p. 3, ll. 8-10). The thermoplastic polymer coating 54 provides a regular outer surface on the non-woven fiber tissue 52 or mat. The material 50 further includes a layer of paint 56 roller-applied to the thermoplastic polymer coating 54 (p. 8, last ¶, p. 10, ll. 9-12 and Figure 3).

The fiber reinforced polymeric wall covering material 50 of claim 36 comprises a non-woven rigid fiber tissue 52 or mat having an inner side and an outer side (p. 7, ll. 5-6). A thermoplastic polymer coating 54 is applied to the outer side of the rigid non-woven fiber tissue 52 or mat (p. 3, ll. 8-10).

Claim 37 covers a fiber reinforced polymeric wall covering material 50 comprising a non-woven fiber tissue 52 or mat having an inner side and an outer side (p. 7, ll. 5-6). A thermoplastic polymer coating 54 is applied to the outer side of the rigid non-woven fiber tissue 52 or mat (p. 3, ll. 8-10). This coating 52 provides a roller paintable, visible outer surface with a surface tension of at least approximately 30 dynes/cm (p. 6, ¶ 2 generally).

Claim 38 reads on a fiber reinforced polymeric wall covering material 50. The material 50 comprises a non-woven fiber tissue or mat 52 having an inner side and an outer side (p. 7, ll. 5-6). A thermoplastic polymer coating 54 is applied to the outer side of the rigid non-woven fiber tissue or mat so as to provide a roller paintable, visible outer surface (p. 3, ll. 8-10 and p. 6, ¶ 2 generally). The polymeric coating 54 comprises approximately a 45/5/50 by weight mixture of high-density polyethylene, an opacifying agent, and a dispersion comprising ground calcium carbonate and ground titanium dioxide in high density polyethylene (page 10, Table 1 and p. 11, ll. 1-3).

Finally, independent claim 40 relates to a fiber reinforced polymeric wall covering material 50. The material 50 comprises a non-woven fiber tissue 52 or mat having a visible inner side and an outer side (p. 7, ll. 5-6). A thermoplastic polymer coating 54 is applied to the outer side of the non-woven fiber tissue or mat 52 (p. 3, ll. 8-10). The thermoplastic polymer coating further comprises a mineral filler to create a non-smooth, roller paintable outer surface on the outer side of the non-woven fiber tissue or mat (p. 11, ¶ 3 generally).

## VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The Board must determine whether claims 1, 8, and 30 meet the requirements of 35 U.S.C. Section 112 of the Patent Act. The Board must further determine whether: (1) claims 1, 3-5, 9, 11-12, 22-23, 25-27, 31, 33-34, 36 and 40 are anticipated by Jackson as further evidenced by WO 95/07946; (2) claims 2, 8, 24, 30, 34, and 37 are obvious in view of Jackson; (3) claims 10, 13, 32, 35 and 38-39 are obvious in view of Jackson and Ishii; and (4) claims 6-7 and 28-29 are obvious in view of Jackson, Ishii, and Penz; and (5) claims 13, 35, and 38 are obvious in view of Jackson, Ishii, and Melber.

## VII. ARGUMENT

### A. CLAIM 1 MEETS THE REQUIREMENTS OF 35 USC SECTION 112

The Examiner rejects claim 1 because it allegedly violates the strictures of Section 112, first paragraph. The genesis for this rejection is “expressed or implied” support is allegedly lacking for the limitation that the thermoplastic polymer coating is “free of random discontinuities.” However, U.S. Patent law does not in any way mandate “expressed support” for a limitation in the specification.<sup>1</sup> Rather, it is sufficient if the originally filed disclosure would have conveyed to one having ordinary skill in the art that the inventor had possession of the concept of what is claimed.<sup>2</sup>

Full support for the “negative” limitations in claim 1 may be found in paragraph 6 of the published application, as well as in the drawing figures (*see, e.g.*, Figure 2 illustrating the continuous, uninterrupted coating 54 free from random discontinuities covering the non-woven fiber tissue or mat 52 to thereby significantly reduce the porosity of the wall covering). These drawings undoubtedly form part of the written description, so “expressed support” for the limitation at issue is thus provided.<sup>3</sup>

Despite acknowledging that Figure 2 illustrates a layer of thermoplastic polymer 54 undoubtedly continuous and uninterrupted, the Examiner contends that “the reference” (presumably, Appellant’s

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<sup>1</sup> *Behr v. Talbott*, [No West Cite] 27 USPQ2d 1401 (BPAI 1992) (“The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed, including the original drawings, would reasonably have conveyed to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.”).

<sup>2</sup> *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

<sup>3</sup> *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) (“drawings alone may provide a ‘written description’ of an invention as required by Section 112”).

specification) “does not teach what are ‘random discontinuities’ as to provide support for the now claimed continuous coating being free of ‘random discontinuities’” (final Office Action mailed August 30, 2006, p. 9, ¶ “b”). The Examiner essentially requires the Appellant to prove a “negative” by showing where an intentionally omitted structure (random discontinuities) is described in Appellant’s specification or shown in the drawings. Simply put, the polymer layer 54 at issue is “free” of random discontinuities, as illustrated, which is all that claim 1 requires.

In maintaining the rejection, the Examiner attempts to characterize the decision cited by the Appellant, *In re Anderson, supra*, as inapposite. However, she completely mischaracterizes the holding of this case and, in doing so, provides an unduly narrow interpretation of the law regarding new matter. Specifically, the Examiner contends that this case stands for the narrow proposition that the “rephrasing of a passage does not constitute new matter” (final Office Action mailed August 30, 2006, p. 8, ¶ “b”). Appellant fully agrees with this statement of the law, but the actual holding of *Anderson* is that a term appearing nowhere in the specification (“carrying”) can be added to a claim without constituting new matter as long as the concept of what is being claimed is present in the original disclosure. *See Anderson*, 471 F.2d at 1244 (“The question, as we view it, is not whether “carrying” was a word used in the specification as filed but whether there is support in the specification for employment of the term in a claim; is the concept of carrying present in the original disclosure?”). Here, this standard is clearly met, since as Appellant points out and the Examiner does not contest, the polymer layer 54 shown in the drawings is continuous and thus “free of random discontinuities.”

The Action further contends that claim 1 runs afoul of Section 112 because the limitation requiring that the “porosity of the wall covering is reduced significantly” by the polymer coating is allegedly indefinite. This indefiniteness results from the alleged fact that “the claim is NOT comparing to what is the reduced porosity compared to . . . is Appellant trying to refer to a reduction of the porosity of the non-woven fiber tissue or mat instead?” (final Office Action mailed August 30, 2006, p. 3, ll. 1-4).

This statement apparently disregards the fact that claim 1 expressly requires that the porosity of the overall wall covering is reduced by the polymer coating covering the non-woven fiber tissue or mat. No reasonable interpretation of the claim or reading of the language would cause a skilled artisan to query whether it is the wall covering or the fiber tissue or mat that has reduced porosity. Indeed, the Examiner’s interpretation is strained, since the porosity of the fiber tissue or mat itself remains unchanged as a result of the polymer covering, even though the porosity of the overall wall covering is understandably reduced by the addition of a layer. Since the language used is perfectly clear and would be easily understood by a skilled artisan, it is believed that the claim is definite and the rejection should be reversed.

The Examiner also suggests that the claim must include a “parameter” that would “allow one of ordinary skill in the art to determine what is the porosity of the claimed material” in order to render the “reduced porosity” limitation definite. (final Office Action mailed August 30, 2006, pp. 7-8, ¶ “a”). Such a requirement is plainly not in accordance with the Manual of Patent Examining Procedure, which explains that “[t]he fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite.”

MPEP § 2173.05(b) (8<sup>th</sup> ed., Rev. 5, Aug. 2006). Here, a skilled artisan would easily understand from the claim language that the porosity of the wall covering is reduced by the addition of the polymer layer without the identification of any parameter. *See, e.g.*, the Jackson patent itself, which in claim 1 recites a “coating being applied at a thickness which is sufficiently low to cause formation of miniature discontinuities . . . ” (Emphasis added). Accordingly, the addition of some precise amount of the reduction achieved, as the Examiner seems to think is required, is unnecessary and would unduly narrow the Appellant’s claim.

In support of this rejection, the Examiner relies on several decisions as standing for the proposition that “[i]t is necessary that the product be described with sufficient particularity that it can be identified so that one can determine what will and will not infringe.” (final Office Action mailed August 30, 2006, pp. 7-8). Aside from being non-precedential, the first decision cited, *Benger Labs, Ltd. v. R.K. Laros Co.*, 209 F. Supp. 639, 135 USPQ 11 (E.D. Pa. 1962) merely stands for the proposition that a patent is not invalid for failing to identify the “precise chemical structure of the claimed product.” Hence, it hardly supports the Examiner’s requirement for more specificity, since its holding is directly the opposite (that is, less specificity is fine in the claims). Also, it deals exclusively with claims to compositions of matter, rather than product claims.

The second decision cited, *In re Bridgeford*, 357 F.2d 679, 149 USPQ 55 (CCPA 1966), dealt exclusively with “product-by-process” claims. There are no such claims in the present application. Thus, this decision is not on point, either.

Aside from also being non-precedential, the third decision cited, *Locklin v. Switzer Bros, Inc.*, 299 F.2d 160, 131 USPQ 294 (9<sup>th</sup> Cir. 1961),

actually supports the Appellant's position. There, the claim required "sufficient melamine" to render a resin "substantially insoluble." *Id.* at 299. The court held that "the fact that the limits of melamine are . . . stated in functional language does not render the patent invalid." *Id.* Thus, quite contrary to the present Examiner's position, specifying a particular parameter or the precise amount of the product in the claim was simply not required in order to comply with Section 112, first paragraph.

Even assuming the law of these cases is as stated by the Examiner, no substantial, objective evidence cited establishes that there has been a violation of Section 112 here. Rather, the Examiner merely states her unsupported opinion that claim 1 is deficient, without even giving a reason as to why a skilled artisan would be unable to ascertain the claim scope. Indeed, Appellant submits that the change suggested by the Examiner to include "language that indicates that the porosity of the wall covering is reduced by comparison to a wall covering without the polymer coating" is not necessary, since this meaning would be clear to a skilled artisan reviewing the present specification, even if such is not expressly set forth in the claims (*see, e.g.*, ¶6 of Appellant's published specification, which explains that "The polymeric coating is a thermoplastic material that covers the surface of the glass fiber tissue, thereby reducing porosity significantly.")).

**B. CLAIMS 8 AND 30 MEET THE REQUIREMENTS OF 35 USC SECTION 112**

The Examiner rejects claims 8 and 30 under Section 112, second paragraph "because the Applicant has not provided a copy of the procedure used to measure the water vapor transmission rate by the DIN Standard 52615" (final Office Action dated August 30, 2006, p. 3, ¶ 3).

“The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe. That determination requires a construction of the claims according to the familiar canons of claim construction.”<sup>4</sup> One of those canons is that claims must be construed as one skilled in the art would understand them in light of the specification of which they are a part.<sup>5</sup>

One skilled in the specifically in the art of providing coverings for objects, such as walls, to reduce vapor transmission is unquestionably familiar with the DIN (German Industrial) Standard 52615. *See, e.g.*, U.S. Patent No. 7,108,227 to Kunzel et al. and U.S. Patent Application Publication Nos. 20060059852, “Laminated building materials”; 20050284096, “Vapor barrier for use in the heat insulation of buildings”; 20030165667, “Tougher, softer nonwoven sheet product”; 20030068483, “Polypropylene base porous film and production process for the same”; and 20030022576, “Microbicidal wallcoverings.” All of these patent documents mention this well-known standard for use in measuring vapor transmission without further elucidating its requirements. Claim 1 in the ‘227 patent even specifically mentions the standard in the same manner as the Appellant, and was allowed without any contention of indefiniteness. This establishes the well-known meaning of this Standard and, thus, its

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<sup>4</sup> *All Dental Prodx, LLC v. Advantage Dental Prods.*, 309 F.3d 774, 779-80, 64 USPQ2d 1945, 1949 (Fed. Cir. 2002) (citations omitted).

<sup>5</sup> *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1575, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

definiteness for purposes of Section 112. The Examiner presents no countervailing evidence or even a reason as to why a skilled artisan would not understand the meaning or scope of Appellant's claims 8 and 30, given the well-known nature of this DIN Standard. Accordingly, reversal of the rejections of these claims under Section 112 is in order.

**C. THE INVENTIONS OF CLAIMS 1, 5, AND 27  
ARE NOT ANTICIPATED BY JACKSON**

The Examiner cites Jackson "as further evidenced by" the Abstract of WO 95/07946 to reject claims 1, 5, and 27 as anticipated. A finding of anticipation is proper "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" MPEP § 2131 (8<sup>th</sup> ed., Rev. 5, Aug. 2006) (Emphasis Added). "Normally, only one reference should be used" in making an anticipation rejection. MPEP § 2131.01 (8<sup>th</sup> ed., Rev. 5, Aug. 2006). However, reliance on a second reference in support of an anticipation rejection "has been held proper when it is cited to: (1) Prove the primary reference contains an 'enabled disclosure'; (2) Explain the meaning of a term used in the primary reference; or (3) Show that a characteristic not disclosed in the reference is inherent." *Id.*

Taking claims 5 and 27 first, the Examiner implicitly admits that Jackson does not disclose each and every element of the claims as required for a proper anticipation rejection. Accordingly, reliance on a second reference, WO 95/079946 is made to show that "the use of resins such as polyethylene in plastisol form to produce a coating material is known in the art" (emphasis added). That the use of polyethylene in plastisol form might be "known in the art" is entirely irrelevant to the consideration of whether Jackson discloses the exact same invention of claims 5 and 27.

Applying the Examiner's logic, no patent would ever issue on a species in combination with another structure simply because the genus without the combination is "known in the art," which simply cannot be the case. Rather, the proper consideration is whether "each and every element as set forth in the claim is found, either expressly or inherently described" in Jackson. Since such is admittedly not the case, the rejection of claims 5 and 27 as anticipated cannot stand.

The Examiner in making the anticipation rejection of claim 1 over Jackson also disregards the plain requirements of the claim. Specifically, claim 1 requires that the claimed coating (not just the surface) is free of random discontinuities that, if otherwise present, would substantially increase porosity of the wall covering. In stark and total contrast, Jackson discloses a wall covering having a "porous polymeric ply . . . fused to and supported by a nonwoven substrate ply" (emphasis added). At column 3, lines 51-55, Jackson expressly defines "porous" and "continuous" synonymously as referring to "the existence of a multitude of small holes, openings or gaps in the polymeric ply of the wallcovering," not just its surface. Noteworthy is the fact that Jackson, choosing to be his own lexicographer, selected a definition of the word "continuous" that does not comport with the ordinary meaning of "uninterrupted."<sup>6</sup>

Jackson thus does not disclose, teach or otherwise suggest a coating that covers the non-woven mat in a continuous fashion (giving "continuous" its ordinary meaning) and free of random discontinuities, as shown in Appellant's Figure 2. Quite the contrary, this reference actually

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<sup>6</sup> *Intellicall, Inc., v. Phonometrics, Inc.*, 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992) ("An inventor may 'be his own lexicographer and . . . give terms uncommon meanings.'"), *but cf.* *Jonsson v. Stanley Works*, 903 F.2d 812, 820, 14 USPQ2d 1863, 1871 (Fed. Cir. 1990) ("[w]ords in a claim ... [are] given their ordinary and accustomed meaning.")

teaches away from such an arrangement by virtue of the critical need for holes in the outer ply of the wall covering (see, e.g., col. 5, lines 45-51, “The key feature of the coating or plastisol application process is that the plastisol is applied very thinly to the nonwoven substate ply . . . [which] results in small discontinuities, holes, or gaps, which upon fusion form miniature holes or pores in the fused polymeric ply” (Emphasis added)). Jackson is also completely silent as to whether the polymeric ply covers the nonwoven substrate in a manner that would in any way facilitate painting (not printing), including by way of a roller. Accordingly, reversal of the rejection of claim 1 is respectfully requested, for the cited reference does not teach the exact invention of this claim.

**D. JACKSON DOES NOT ANTICIPATE CLAIMS 9, 23 AND 31**

Claims 9, 23 and 31 also stand rejected as anticipated by Jackson “as further evidenced by” the Abstract of WO 95/07946. Neither reference discloses, teaches, or suggests the exact invention of claim 23 as a whole, including a layer of paint roller-applied to a thermoplastic polymer coating applied to a non-woven fiber tissue or mat. Since this express structural element of claim 23 is completely disregarded by the Examiner in the final rejection, reversal of the rejections is in order.

Dependent claims 9 and 31 require that the polymer coating further comprises an opacifying agent in an amount sufficient to create an opacity in the wall covering of between approximately 70 and 90%. Jackson is completely silent as to any range of opacity such as that claim. Accordingly, it cannot anticipate the inventions of these claims. Nothing in WO 95/07946 cures this remarkable deficiency of Jackson.

**E. CLAIMS 6-7 AND 28-29 ARE PATENTABLE  
OVER JACKSON AND PENZ**

Claims 6-7 and 28-29 require a mineral filler to form a non-smooth outer surface. These claims stand rejected based on the combination of Jackson in view of Ishii (which is never discussed in the rejection) and Penz. Penz is cited for its disclosure of a glass mat reinforced thermoplastic suitable for the production of paintable parts comprising a thermoplastic matrix polymer, one or more glass mats, and a fine-particle mineral fiber. The primary contention made in support of the rejection is that “[s]ince both Jackson et al and Penz et al. are from the same field of endeavor, the purpose disclosed by Penz et al. would have been recognized in the pertinent art of Jackson et al.” (Office Action of August 30, 2006, p. 6, ¶ 9).

Appellant respectfully requests reconsideration on the ground that a skilled artisan would not combine Jackson and Penz to arrive at the present invention simply because they are “from the same field of endeavor” or that the “purpose” of one would have been recognized in the “pertinent art” of the other. Specifically, one of ordinary skill in the art would not use the teaching of Penz to include a mineral filler in the chemical composition of the polymeric coating to create a non-smooth surface in combination with Jackson, when in fact Jackson expressly teaches that such a feature is not a desirable attribute of a wall covering (*see, e.g.*, col. 2, lines 5-12). Indeed, Jackson extols the desirability of providing a wall covering with a smooth outer surface (see Abstract, line 1), and simply does not contemplate in any way imparting a mineral filler to create a non-smooth outer surface to facilitate roller painting. Incredibly, the Examiner ignores this express teaching and instead

contends that both Jackson and Penz “avoid having ‘smooth’ surfaces,” which is simply not true.

When properly interpreted, Jackson thus actually teaches away from the claimed invention, and otherwise fails to motivate a skilled artisan to combine the teachings of Penz to provide a wall covering with a non-smooth outer surface formed using a mineral filler. As observed by the Court of Appeals for the Federal Circuit, “[e]lements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents.”<sup>7</sup> That is clearly the situation here, so reversal of the rejections is in order.

The Examiner in the final Office Action indicates that she “reviewed the cited passage” of Jackson at col. 2, lines 5-12 “and finds no correlation to applicant’s conclusion of teaching away.” The cited passage specifically disparages a prior art acoustic lamina because it has a “rough textured surface.” Contrasting this prior art, the next sentence then states that “there exist[s] a need for a . . . wall covering having a relatively higher permeability, yet which has a smooth outer exposed surface.” Appellant thus submits that there is a clear factual predicate for a “teaching away” of surface roughening a wall covering of the type claimed by including mineral fillers of Penz. *See, e.g. In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994) (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”). By

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<sup>7</sup> *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

disregarding this teaching, the Examiner simply refuses to consider Jackson "as a whole," as is required by numerous precedential decisions.

**F. CLAIMS 10, 13, 32, 35 AND 38-39 PATENTABLY  
DISTINGUISH OVER JACKSON IN VIEW OF IISHI**

Despite Appellant's protestations, absolutely no reason is provided in the final Office Action of August 30, 2006, to explain why a skilled artisan would combine the teachings of Iishi with those of Jackson to arrive at the claimed invention. Rather, the Examiner simply selects bits and pieces of the teachings of these references as necessary to meet the terms of Appellant's claimed invention. Such a hindsight approach using Appellant's specification and claims as a blueprint has long been assailed.<sup>8</sup> Absent such a motivation or suggestion in the prior art, the rejections of claims 10, 13, 32, 35, and 38-39 relying on Ishii cannot stand and should be withdrawn.

With specific regard to claims 13, 35, and 38 each further requires that the polymeric material comprises approximately a 45/5/50 by weight mixture of high-density polyethylene, titanium dioxide, and a dispersion, said dispersion comprising ground calcium carbonate and ground titanium dioxide in high density polyethylene. The primary reference to Jackson specifically requires a plastisol as a component of the polymer coating, which by definition includes a plasticizer. Such is clearly excluded by the plain terms of these claims, which do not recite a plasticizer as a part of the 100 weight percent of the polymeric material. Melber reference does nothing to cure this deficiency, and is otherwise not

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<sup>8</sup> *In re Ochiai*, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), citing *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

properly combinable with the Jackson and Ishii references since a proper motivation or suggestion for doing so is not in any way identified.

As for claims 10, 32, and 39, the Examiner contends that Jackson “discloses the claimed invention except that it teaches the use of titanium oxide instead of titanium dioxide.” Again, this is simply not true, since Jackson fails to disclose, teach, or suggest in any way a mixture of high-density polyethylene or a dispersion comprising ground calcium carbonate and ground titanium dioxide in high density polyethylene (all of which form part of the “claimed invention”). The Examiner does not contest Appellant’s argument, but instead cites to Ishii as disclosing that titanium dioxide is an “equivalent” of titanium oxide. Regardless of whether Ishii discloses titanium dioxide, and assuming for the sake of argument that the references are properly combinable, this secondary reference does not otherwise supply the teaching missing from Jackson necessary to render the inventions of these claims obvious. Accordingly, since the cited combination of references fail to teach every limitation of the claim at issue, a *prima facie* case of obviousness is lacking and reversal of the corresponding rejections is in order.

#### **G. CLAIM 36 IS PATENTABLE OVER JACKSON**

Claim 36 stands rejected as anticipated by Jackson “as further evidenced by” the Abstract of WO 95/07946. Claim 36 expressly requires a “rigid” fiber tissue or mat. In stark contrast, Jackson teaches that the structure allegedly corresponding to the claimed tissue or mat is “soft.” Nevertheless, the Examiner asserts in making the rejection that “the term soft means smooth or delicate in texture, grain or fiber” (Office Action of January 17, 2006, pp. 5-6, ¶ f) without supplying any copy of the definition used). On the basis of this random definition, it is concluded that the fact

that Jackson “refers to a soft fabric does not preclude that it forms a rigid structure.” *Id.*

First of all, precedential decisions make clear that “[i]ndiscriminate reliance should not be placed on layman's definitions found in dictionaries.”<sup>9</sup> Rather, the reference itself must always be consulted to determine the meaning given to a particular term. Jackson at several locations uses the word “smooth” to describe the substrate ply, including in the same sentence with the word “soft” (*see, e.g.*, col. 2, lines 40-44). Accordingly, the layman’s meaning of “soft” ascribed by the Examiner cannot be the correct one, or else Jackson would not have used it consistently throughout instead of also using the word “smooth.”

Regardless, the Examiner overlooks an important point: The fact that Jackson “does not preclude” a rigid structure does not mean that it “discloses” a rigid structure for purposes of an anticipation rejection. Indeed, the Examiner points to nothing in Jackson that in any way discloses, teaches, or suggests the claimed rigid fiber tissue or mat. Using the Examiner’s same logic in reverse, the mere fact that Jackson mentions a soft structure does not mean it is necessarily rigid (and the “mere possibility” that such is the case cannot support an anticipation rejection). Since the rejection is thus based on a *non-sequitur* and the Examiner otherwise carries no part of her burden of showing that Jackson within its four corners discloses the non-woven rigid fiber tissue or mat of claim 36, or that such would be inherent, a *prima facie* case of anticipation is lacking. The rejection of claim 36 must therefore be reversed.

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<sup>9</sup> *Ex parte Kumagai*, 9 USPQ2d 1642 (BPAI1988) (citing *In re Salem*, 533 F.2d 676, 193 USPQ 513, 518 (CCPA 1977) with approval and noting that “the lay definition of ‘discrete’ relied upon by the examiner does not even suggest its applicability to [this] technical area.”)

#### H. CLAIMS 2, 24 AND 37 ARE PATENTABLE OVER JACKSON

Although believed to be allowable as dependent on an allowable base claim, the independent patentability dependent claim 2, requiring the outer surface of the polymer coating have a surface tension of at least approximately 30 dynes/cm. The Examiner acknowledges that Jackson is completely silent as to the claimed surface tension, and no other reference is cited as allegedly supplying this missing teaching. However, the conclusion is nevertheless reached, without citation to any substantial evidence, that such a surface tension would be "inherent to the product of the prior art as it meets all the structural limitations of the present invention." As a result, the Examiner concludes the invention of this claim is "obvious." The same analysis is applied in rejecting dependent claim 24 and independent claim 37, which also require a polymer coating have a surface tension of at least approximately 30 dynes/cm.

These rejections contravene not only to the Manual of Patent Examining Procedure, but also precedential decisions holding that "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."<sup>10</sup> Not only do the steps described for forming the claimed wall covering differ completely from those outlined in Jackson, but Appellant's processing involves a treatment designed to impart a particular surface tension in order to facilitate roller painting. As acknowledged in the record, Jackson fails to mention the surface tension of the substrate or any

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<sup>10</sup> See *Ex parte Levy*, [No West Cite] 17 USPQ2d 1461, 1464 (BPAI 1990) and MPEP § 2112, generally.

steps taken to alter it, and actually uses different materials. Accordingly, it cannot possibly render the inventions of claims 2 or 37 obvious.

In the alternative, the Examiner asserts that the “presently claimed function of surface tension . . . would have obviously been provided as a result of the product of” Jackson, apparently relying on a theory of “obviousness by inherency.” However, “[t]hat which may be inherent is not necessarily known” and “[o]bviousness cannot be predicated on what is unknown.”<sup>11</sup> Moreover, “a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection.”<sup>12</sup> Since Jackson nowhere contemplates, teaches, suggests, or even discusses surface tension to improve the roller paintability of a wall covering, it standing alone cannot possibly make it known to provide a surface tension within the claimed range.

In an effort to refute Appellant’s position, the Examiner cites to *In re Skoner*, 186 USPQ 80 (CCPA 1975) for the proposition that “reliance on inherency is not improper even though [*sic a*] rejection is based on Section 103 instead of Section 102.” While that is no doubt the holding of that case, it resulted from a much different factual situation than the one confronting the Examiner. In *Skoner*, the claim at issue covered wire brushing to a certain extent to produce a certain surface condition. The prior art reference taught wire brushing generally, but not to the extent required to produce what was claimed. Understandably, the Board was willing to find that wire brushing to the extent claimed was inherent in the reference, given that wire brushing was generally disclosed.

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<sup>11</sup> *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966).

<sup>12</sup> *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

In stark and total contrast, nothing in Jackson even remotely mentions enhancing surface tension using any process, let alone surface tension in general. Thus, it simply cannot be the case that the value suggested by the Appellant as creating advantageous surface characteristics for purposes of roller painting are “inherent” in Jackson. Thus, *Skoner* is inapposite and does not support the examiner’s position.

Looking at the situation from a different perspective, Jackson does not “enable” a skilled artisan to make a wall covering having the claimed surface tension. There can be no doubt that Jackson does not describe Appellant’s claimed invention sufficient to place it in possession of a person of ordinary skill in the art, when in fact the particular surface tension claimed by the Appellant is not even remotely mentioned. Accordingly, it cannot be the case that Jackson renders the claimed inventions unpatentable, and reversal of the rejections is in order.

#### **I. CLAIM 40 IS PATENTABLE OVER JACKSON**

Claim 40 requires a thermoplastic polymer with a mineral filler forming a visible outer, non-smooth roller paintable surface of a wall covering with a non-woven tissue or mat having a visible inside surface as well. As noted above, Jackson specifically extols a smooth outer surface, and concomitantly disparages a non-smooth outer surface. See col. 2, lines 5-16. Despite the contrary admission by the Examiner that Jackson teaches a smooth surface (see the final Office Action dated August 30, 2006, p. 3, ¶ 6, “JACKSON teaches a breathable, decorative wall-covering having a smooth exposed surface . . . .” (Emphasis added)), this claim requiring the exact opposite structure as that taught in the prior art reference cited is still rejected as being anticipated. Since the Examiner’s inconsistent positions

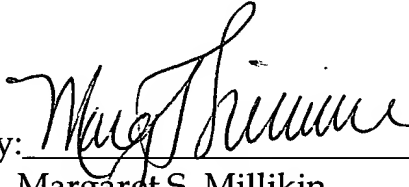
are untenable, Appellant respectfully requests that the Board reverse the rejection as improper.

J. CONCLUSION

In summary, Appellant has addressed and met every rejection set forth in the last Office Action and asseverates that all of the rejected claims meet the statutory requirements for patentability. Thus, it is respectfully requested that all outstanding rejections of all claims be reversed and that the present application be remanded to the Examiner with instructions for immediate allowance

Respectfully submitted,

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### VIII. CLAIMS APPENDIX

The claims on Appeal read as follows:

1. (previously presented) A fiber reinforced polymeric wall covering material comprising:
  - a non-woven fiber tissue or mat having an inner side and an outer side; and
  - a thermoplastic polymer coating covering said outer side of said non-woven fiber tissue or mat in a continuous fashion to reduce significantly the porosity of the wall covering, said thermoplastic polymer coating providing a regular, roller paintable visible outer surface on said non-woven fiber tissue or mat, said continuous coating being free of random discontinuities that increase porosity and which are susceptible to creating visible irregularities when the surface is roller painted.
2. (previously presented) The polymeric wall covering material of claim 36, wherein an outer surface of said thermoplastic polymer coating has a surface tension of at least approximately 30 dynes/cm.
3. (previously presented) The polymeric wall covering material of claim 36, wherein said thermoplastic polymer coating is applied to said non-woven tissue or mat at between approximately 5 and 200 g/m<sup>2</sup>.
4. (previously presented) The polymeric wall covering material of claim 36, wherein said thermoplastic polymer coating is applied to said non-woven tissue mat at between approximately 30 and 60 g/m<sup>2</sup>.

5. (previously presented) The polymeric wall covering material of claim 36, wherein said thermoplastic polymer coating comprises a matrix polymer resin selected from the group consisting of low density polyethylene, high density polyethylene, polypropylene, and combinations thereof.
6. (previously presented) The polymeric wall covering material of claim 5, wherein said thermoplastic polymer coating further comprises a mineral filler to create a non-smooth outer surface, wherein said mineral filler comprises between approximately 1 and 50% by weight of said thermoplastic polymer coating.
7. (previously presented) The polymeric wall covering material of claim 6, wherein said mineral filler is selected from the group consisting of calcium carbonate, mica, talcum, clay, and combinations thereof.
8. (previously presented) The polymeric wall covering material of claim 36, wherein said wall covering material has a water vapor transmission rate of at least approximately 1 gram/m<sup>2</sup> per day as measured by DIN Standard 52615 utilizing a wet cup process.
9. (previously presented) The polymeric wall covering material of claim 5, wherein said thermoplastic polymer coating further comprises an opacifying agent, wherein the amount of said opacifying agent in said thermoplastic polymer coating is sufficient to create an opacity in the wall covering of between approximately 70 and 90%.

10. (previously presented) The polymeric wall covering material of claim 9, wherein said opacifying agent comprises titanium dioxide.

11. (previously presented) The polymeric wall covering material of claim 36, wherein said non-woven fiber tissue or mat is comprised of predominantly a first fiber type, said first fiber type selected from the group consisting of inorganic fibers and mineral fibers.

12. (previously presented) The polymeric wall covering material of claim 36, wherein said non-woven fiber tissue or mat comprises a non-woven fiber or mat having an area weight of approximately 20 to 60 g/m<sup>2</sup>.

13. (previously presented) The polymeric wall covering material of claim 36, wherein said polymeric material comprises approximately a 45/5/50 by weight mixture of high-density polyethylene, titanium dioxide, and a dispersion, said dispersion comprising ground calcium carbonate and ground titanium dioxide in high density polyethylene.

14 - 21. (cancelled)

22. (previously presented) The polymeric wall covering material of claim 36, wherein said thermoplastic polymer coating is applied to said non-woven tissue or mat at between approximately 50 and 200 g/m<sup>2</sup>.

23. (previously presented) A fiber reinforced polymeric wall covering material comprising:

a non-woven fiber tissue or mat having an inner side and an outer side;

a thermoplastic polymer coating applied to said outer side of said non-woven fiber tissue or mat, said thermoplastic polymer coating providing a regular outer surface on said non-woven fiber tissue or mat; and

a layer of paint roller-applied to said thermoplastic polymer coating.

24. (previously presented) The fiber reinforced polymeric wall covering material of claim 23, wherein said outer surface of said thermoplastic polymer coating has a surface tension of at least approximately 30 dynes/cm.

25. (previously presented) The polymeric wall covering material of claim 23, wherein said thermoplastic polymer coating is applied to said non-woven tissue or mat at between approximately 5 and 200 g/m<sup>2</sup>.

26. (previously presented) The polymeric wall covering material of claim 23, wherein said thermoplastic polymer coating is applied to said non-woven tissue mat at between approximately 30 and 60 g/m<sup>2</sup>.

27. (previously presented) The polymeric wall covering material of claim 23, wherein said thermoplastic polymer coating comprises a matrix polymer resin selected from the group consisting of low density polyethylene, high density polyethylene, polypropylene, and combinations thereof.

28. (previously presented) The polymeric wall covering material of claim 27, wherein said thermoplastic polymer coating further comprises a mineral filler to create a non-smooth outer surface, wherein said mineral filler comprises between approximately 1 and 50% by weight of said thermoplastic polymer coating.

29. (previously presented) The polymeric wall covering material of claim 28, wherein said mineral filler is selected from the group consisting of calcium carbonate, mica, talcum, clay, and combinations thereof.

30. (previously presented) The polymeric wall covering material of claim 23, wherein said wall covering material has a water vapor transmission rate of at least approximately 1 gram/m<sup>2</sup> per day as measured by DIN Standard 52615 utilizing a wet cup process.

31. (previously presented) The polymeric wall covering material of claim 27, wherein said thermoplastic polymer coating further comprises an opacifying agent, wherein the amount of said opacifying agent in said thermoplastic polymer coating is sufficient to create an opacity in the wall covering of between approximately 70 and 90%.

32. (previously presented) The polymeric wall covering material of claim 31, wherein said opacifying agent comprises titanium dioxide.

33. (previously presented) The polymeric wall covering material of claim 23, wherein said non-woven fiber tissue or mat is comprised of

predominantly a first fiber type, said first fiber type selected from the group consisting of inorganic fibers and mineral fibers.

34. (previously presented) The polymeric wall covering material of claim 23, wherein said non-woven fiber tissue or mat comprises a non-woven fiber or mat having an area weight of approximately 20 to 60 g/m<sup>2</sup>.

35. (previously presented) The polymeric wall covering material of claim 23, wherein said polymeric material comprises approximately a 45/5/50 by weight mixture of high-density polyethylene, titanium dioxide, and a dispersion, said dispersion comprising of ground calcium carbonate and ground titanium dioxide in high density polyethylene.

36. (previously presented) A fiber reinforced polymeric wall covering material comprising:

- a non-woven rigid fiber tissue or mat having an inner side and an outer side; and

- a thermoplastic polymer coating applied to said outer side of said rigid non-woven fiber tissue or mat.

37. (previously presented) A fiber reinforced polymeric wall covering material comprising:

- a non-woven fiber tissue or mat having an inner side and an outer side; and

- a thermoplastic polymer coating applied to said outer side of said rigid non-woven fiber tissue or mat and having a roller paintable, visible

outer surface with a surface tension of at least approximately 30 dynes/cm.

38. (previously presented) A fiber reinforced polymeric wall covering material comprising:

a non-woven fiber tissue or mat having an inner side and an outer side; and

a thermoplastic polymer coating applied to said outer side of said rigid non-woven fiber tissue or mat and providing a roller paintable, visible outer surface;

wherein said polymeric coating comprises approximately a 45/5/50 by weight mixture of high-density polyethylene, an opacifying agent, and a dispersion, said dispersion comprising ground calcium carbonate and ground titanium dioxide in high density polyethylene.

39. (previously presented) The polymeric wall covering material of claim 38, wherein the opacifying agent is titanium dioxide.

40. (previously amended) A fiber reinforced polymeric wall covering material comprising:

a non-woven fiber tissue or mat having a visible inner side and an outer side; and

a thermoplastic polymer coating applied to said outer side of said non-woven fiber tissue or mat, said thermoplastic polymer coating further comprising a mineral filler to create a non-smooth, roller paintable outer surface on the outer side of the non-woven fiber tissue or mat.

**IX. EVIDENCE APPENDIX**

None

**X. RELATED PROCEEDINGS APPENDIX**

None